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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/594,327	01/30/96	ESCH	H 221702-9320
		EXAMINER	
		11M1/1206	
		HENDRICKSON, S.	ART UNIT PAPER NUMBER
			20
		1103	
		DATE MAILED:	12/06/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 8/6/96

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1 and 7 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
 Claim(s) _____ is/are allowed.
 Claim(s) 1 and 7 is/are rejected.
 Claim(s) _____ is/are objected to.
 Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
 The drawing(s) filed on _____ is/are objected to by the Examiner.
 The proposed drawing correction, filed on _____ is approved disapproved.
 The specification is objected to by the Examiner.
 The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____
 received in this national-stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). 19
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) In claim 1 lines 7-8, "ml ... pH of 7" is unclear since it varies as the NaOH concentration varies. If the amount of NaOH of a certain concentration required to neutralize the material is meant, it should be clearly stated.
- b) In line 12 of claim 1, V_1 and V_2 are not defined.

Claims 1 and 7 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Lagarde et al.

The reference teaches in col.2 lines 5-35 and col.9 lines 1-10 silica having BET 242, CTAB 237, BET/CTAB=1.02. The other properties, to the extent the claim can be comprehended, are deemed inherently possessed since the BET, CTAB and their ratio are the same as claimed; where the examiner has found substantially the same product as claimed in the art but cannot determine whether the reference inherently meets the claimed limitations, the burden is upon the applicant to show a difference; In re Fitzgerald et al. 205 USPQ 594.

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To the extent that the examples are not considered anticipatory, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make silica having the claimed properties since doing so provides a fine silica having properties desired by Lagarde col. 1 lines 65-68. With regard to the overlapping general values disclosed in col. 2 lines 1-35, (also taught is a particle size of essentially less than 45 microns), the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson et al. (4681750).

Johnson teaches in col. 2 line 25-col. 3 line 5 and col. 5 lines 35-68 precipitated silica having BET in the claimed range, made in a manner substantially the same as disclosed. An alkaili silcate is acidified at the disclosed temperature to the same pH, continuing the reaction for a desired time period and acidifying again to the same disclosed lower pH. The product is then washed and dried, as disclosed. Even though the claimed physical

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properties are not disclosed by Johnson, the product thereof is deemed to possess them nonetheless since it was made in essentially the same manner as instantly disclosed. Note In re Fitzgerald et al., *supra*.

Applicant's arguments filed through 8/6/96 have been fully considered but they are not deemed to be persuasive.

Concerning Lagarde, the intended use of the material does not limit it; no differences in the product claimed have been shown and the claims are not limited to the unexpected results alleged. The disclosed process also has many steps and in any event a product, not process, is being claimed. There are no limitations as to the sodium content and the V terms are not defined so arguments thereto are not persuasive. The last 9 lines of the abstract should be deleted and the DBP/CTAB corrected.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.

Wayne Langel
WAYNE LANGEL
PRIMARY EXAMINER
GROUP 110